UNITED STATES PATENT AND TRADEMARK OFFICE

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Robert H. Frantz	GARG, YOGESH C
P.O. Box 23324	
Oklahoma City, OK 73123-2334	

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Robert H. Frantz
P.O. Box 23324
Oklahoma City, OK 73123-2334

EXAMINER
Yogesh C. Garg

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Commissioner for Patents

Yogesh C Garg
Primary Examiner
Art Unit: 3625

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/944,518
Filing Date: August 31, 2001
Appellant(s): JANAKIRAMAN ET AL.

MAILED

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GROUP 3600

Robert Frantz
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/27/2007 appealing from the Office action

mailed 11/28/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment after final rejection filed on 4/26/2007 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,493,6758	McLAIN	12-2002
6,108,316	AGARWAL et al.	08-2000

((9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims, as

reproduced from the final office action mailed on 11/8/2006:

Claim Rejections - 35 USC § 112

3.1.   The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of
making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to
which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the
best mode contemplated by the inventor of carrying out his invention.

Claims 22-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the
written description requirement. The claim(s) contains subject matter , "**providing a web server with at
least two sets of web objects for a web page including at least set of web objects previously
designated as essential objects**" which was not described in the specification originally filed claims in
such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the
application was filed, had possession of the claimed invention. The originally filed specifications and the
claims specify selecting essential objects but do not disclose the step of listing that some objects were
specifically previously designated as essential objects. Previously designated would imply that either a
human or the system lists out the essential objects/information/data and only those listed or earmarked
objects/information/data should be regarded as previously designated essential material but the
applicant's disclosure does not teach or suggest the same. Therefore, the above recited limitation, when
broadly interpreted in the light of the applicant's disclosure will not include irrelevant material or
information, as also disclosed in McLain, see col.2, lines 8-16, which will unnecessary use space of the

memory of the mobile device or use the low battery life of the mobile device. These limitations would be further treated as analyzed above for prior art rejection.

3.2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:
        The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

        Claims 22-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
        Claim 22 recites the limitation "said advertisement" in line 11. There is insufficient antecedent basis for this limitation in the claim. Claims 28 and 34 also include the same deficiency and are therefore rejected for the same reason. Since claims 23-27, 29-33 and 35-39 are dependencies of claims 22, 28 and 34 they will inherit the same deficiency.

Specification

4.   The currently amended independent claims 22, 28 and 34 and their dependencies filed 9/13/2006 are objected to under 35 U.S.C. 132(a) because they introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "**providing a web server with at least two sets of web objects for a web page including at least set of web objects previously designated as essential objects**" which was not described in the specification originally filed claims in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specifications and the claims specify selecting essential objects but do not disclose the step of listing that some objects were specifically previously designated as essential objects. Previously designated would imply that either a human or the system lists out the essential objects/information/data and only those listed or earmarked objects/information/data should be regarded as previously designated essential material but the applicant's disclosure does not teach or suggest the same. Therefore, the above recited limitation, when broadly interpreted in the light of the applicant's disclosure will not include irrelevant material or information, as also disclosed in McLain, see col.2, lines 8-16, which will unnecessary use space of the memory of the mobile device or use the low battery life of the mobile device. These limitations would be further treated as analyzed above for prior art rejection.
        Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
        (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.1.   Claims 22-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLain in view of Agrawal.

        Regarding claim 22, McLain in view of Agrawal teaches a method for preserving battery life for a portable networked client device said method comprising the steps of:
        providing a web server with at least two sets of web objects for a web page including at least set of web objects previously designated as essential objects, selecting only said essential web objects in a web page for transmission by said web server to said client device on receipt of a particular information about the mobile client device, otherwise selecting all web objects in both said essential set and said advertisement set; and transmitting said selected web objects from said server to said networked client

device so that the remaining hardware and software component , such as that of a memory is not wasted, but in doing so its availability or life is extended (see at least Abstract, Fig.6 , col.2, lines 8-16, lines 25-34, col.3, lines 40-49 col.7, line 32-col.11, line 32, col.8, lines 18-37 and col.9, line 51-col.10, line 34. McLain teaches providing a server with a plurality of web objects which include both essential that is relevant data and irrelevant, that is non-essential data. McLain fairly discloses and suggests that the data or web objects could be related to advertisement/graphical web objects/video segment & clip objects/sound and audio web objects/ multicolor web objects, see at least col.8, lines 18-37 and col.9, line 51-col.10, line 34 which disclose that the user's mobile device can receive multi-media data including web objects that are related to graphical web objects/video segment & clip objects/sound and audio web objects/ multicolor web objects. McLain also teaches that the user's mobile device can receive/download data from external sites which, as well-known, could include advertisements which could be displayed in the form of text/ graphical images/multicolor images. McLain teaches that based upon receiving characteristic information of the mobile client device pertaining to hardware/software capabilities the host computer, that is the web server in the claimed application, transfers/downloads only selected essential content as desired.).

McLain does not teach that the particular information received [by the web server that is the host computer in McLain] about the mobile client device is related to the condition of battery of the mobile client device being low, determining the condition of a battery in a networked client device and transmitting said battery condition from said mobile client device to the web server enabling the server to restrict the transfers of web objects so that the remaining battery life is extended for said networked client device under conditions of low battery. However, in the same field of endeavor, Agrawal discloses determining the condition of a battery in a networked client device and transmitting said battery condition from said networked client device to a web server and if the battery condition is low prompting the receiving computing device to take action based upon the low condition of the battery(see at least Agrawal: Abstract, col.1, lines 44-67. Agrawal describes determining a particular parameter/characteristic of the mobile client device, that is battery power level of the mobile client device, and based on the detection of this parameter transmitting said parameter, that is battery condition to a base station which takes further action in response to detection of a particular parameter, that is low battery power level. The base station in Agrawal comprises a computer which receives the signal of low battery and so is the case in the claimed invention, that is a web server comprising a computer receiving the signal of low battery from a networked mobile client device).

In view of Agrawal, it would be obvious to one of an ordinary skilled in the art, at the time of the applicant's invention, to have modified McLain to combine Agrawal's features of determining the condition of a battery in the mobile client device and transmitting said battery condition from said mobile client device to the web server because, as taught in Agrawal, it would enable the host computer in McLain to further improve its objective of downloading data in mobile client devices efficiently from web sources without wasting the memory's storage capacity of the mobile client device and instead increasing the expected life (see McLain col.2, lines 8-17) by prioritizing the transmission/downloading of essential data as per the user's preference that is if the user has indicated preference for audio data then to transmit on priority the audio data excluding the text/graphical/video data in order to complete the downloading efficiently of the required data only before the battery becomes dead.

McLain teaches (see at least Abstract, Fig.6 , col.2, lines 25-34, col.3, lines 40-49 and col.7, line 32-col.11, line 32) based upon receiving characteristic information of the mobile device pertaining to hardware/software capabilities the host computer, that is the web server in the claimed application, transfers/downloads only selected essential content as desired. McLain teaches that such an action is taken by the server in response to signals receiving from hardware and software components of a mobile client device and those signals are related to the characteristics of their capabilities, such as limited capacity of the memory so that only selected or essential data is downloaded (Note: The available storage capacity of the memory of the mobile device at any time is not fixed but is variable depending upon how much it has been used and the server by restricting the transfers/downloads of the filtered essential data stops the wasting of the memory resulting in extending the use of the memory component). McLain's suggestion of restricting downloads of data is not solely directed to the memory's capacity but instead it suggests that such transfers and downloads of data can be limited in response to

receiving signals about the characteristics of the capabilities of both hardware and software components of the mobile device (see at least Abstract) and the hardware and software components do include the battery of the mobile device. McLain does not explicitly disclose as an example the restriction of transfers of data based upon reducing battery power as it has shown for the capability of memory but it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified McLain in view of Agrawal's teachings to reduce or limit transfers/downloads of data to the mobile device on receiving signals of low battery power levels so as not waste the remaining battery power with irrelevant transfers/downloads of data as it is already doing with other components, for example storage capacity of the memory

5.2.   Regarding claims 28 and 34, their limitations are closely parallel to the limitations of claim 22 and are therefore analyzed and rejected on the same basis.

5.3.   Regarding claims 23-27, 29-33 and 35-39 , McLain in view of Agrawal discloses that the data or web objects could be related to advertisement/graphical web objects/video segment & clip objects/sound and audio web objects/ multicolor web objects (see at least col.8, lines 18-37 and col.9, line 51-col.10, line 34 which disclose that the user's mobile device can receive multi-media data including web objects that are related to graphical web objects/video segment & clip objects/sound and audio web objects/ multicolor web objects. McLain also teaches that the user's mobile device can receive/download data from external sites which, as well-known, could include advertisements which could be displayed in the form of text/ graphical images/multicolor images).

(10) Response to Argument

A.   Rejection of Claims 22-34 Under 35 U.S.C. 112, First Paragraph.

The Applicant's arguments (see AB, pages 4-5 and page 8) are persuasive and rejection of claims 22-34 Under 35 U.S.C. 112, First Paragraph and Objection to Specification under 35 USC 132(a) are withdrawn.

B.   Rejection of Claims 22-39 Under 35 U.S.C. 112, Second Paragraph.

The Applicant's amendment filed on April 26, 2007 after the final office action Is entered. In view of this amendment the rejection of claims 22-39 Under 35 U.S.C. 112, Second Paragraph is withdrawn.

C.   Rejection of Claims 22-39 Under 35 U.S.C. 103(a) over McLain in view of

Agrawal

The applicant argues, (i) see AB page 6 paragraph "A", since McLain's

technology is directed towards restricting information to be transferred to a mobile

device based upon a non variable condition namely memory capacity, McLain does not

contain a suggestion to adapt or modify to determine which objects to transfer based

upon variable condition such as battery life, (ii) see AB pages 6-7 paragraph "B",

McLain does not teach minimizing battery energy consumption or battery life because it

teaches minimizing memory and Agrawal does not teach suppressing downloading of

non-essential web-objects and (iii) Agrawal's technology is directed towards the reverse

transfer of information from the mobile station to the base station. The examiner

respectfully disagrees for following reasons:

In response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). In the instant case, the examiner has combined the teachings of both McLain

and Agrawal to arrive at the claimed invention of independent claim 22 and therefore

the applicant's piecemeal arguments against McLain and Agrawal are not persuasive.

McLain teaches restricting information to be transferred to a mobile device based

upon obtaining characteristic information of the mobile device pertaining to either

hardware or software capabilities of the mobile device (see at least Abstract, col.2, lines

8-16 and 25-34). The hardware, when according broadest possible interpretation,

includes hardware such as a memory device or battery device used to power the mobile

device. Both the memory device and battery device have limited and variable capacities

because with progressive use of each of them their capacities reduce. McLain has

suggested to restrict transfer of irrelevant information upon obtaining characteristic

information of either hardware or software capabilities of the mobile device resulting in

optimization of the use of the available but limited and variable resources which can

include both the memory device and the battery device. McLain, in the preferred

embodiment, has referred to the memory device and not the battery device. But at the

time of the applicant's invention it was known to consider the limited battery power

source of the mobile device to optimize the use of the mobile device in view of its

depleting power capacity (see Agrawal, Abstract and col.1, line 44-col.2, line 26 and

fig.5.). Agrawal teaches in a wireless communication system that a base station in

communication with the mobile terminal receives signals about the low battery condition

of the mobile terminal and based upon this signal the base station is able to change the

schedule of the transmission of messages from the mobile terminal with low battery. In

view of McLain and Agrawal, it would be obvious to one of an ordinary skilled in the art

of designing hardware and software for mobile devices working with limited and variable

resources, such as memory and battery power to utilize the concepts of McLain and

Agrawal to design system hardware and software to optimize the use of the variable

resources including both the memory capability and battery power of the mobile

devices. McLain does not teach away from combining the Agrawal's concept of taking

an action to optimize the mobile device's operation upon obtaining the characteristic of depleting battery power of the mobile device.

Claim 22 of the applicant's application simply recites limitations related to optimizing the use of mobile devices by sensing indication of the depleting capacity of at least one hardware element as disclosed in McLain and Agrawal. In McLain, based upon obtaining the characteristic of depleting memory availability of the mobile device, the transfer of content is restricted to the mobile device and in Agrawal, based upon obtaining the characteristic of depleting battery power of the mobile station, the base station changes the transmission schedule of the mobile station. In the instant case, the limitations of claim 22 extend to obvious combination of the combined teachings of McLain and Agrawal because at the time of the applicant's invention the problem of obtaining characteristic information of the mobile device pertaining to the depleting capacity of a hardware device including both the memory availability and battery power and its solution were known, as is evident from the teachings of McLain and Agrawal. Since the claim 22 limitations are within the objective reach of the prior art teachings the claim is obvious and should be rejected under 35 USC 103.

The examiner's reasons for combining the teachings of McLain with Agrawal's teachings also find support from the following pertinent court cases:

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does

not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

1971). In the instant case, the examiner has used the objective reach of the combined

teachings of McLain and Agrawal only to arrive at the claimed invention and has not

included any knowledge from the applicant's disclosure.

Further, in response to applicant's argument that there is no suggestion to

combine the references, the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the

claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

the examiner has combined the claimed elements from the existing teachings in McLain

and Agrawal and the knowledge to suggest to combine the McLain teachings was

generally obvious/available to one of ordinary skilled in the art because it was objective

to extend the McLain method and system in receiving low battery power information

from the mobile device so as to transfer the content to the mobile device as a function of

the battery power information so as not to waste the depleting battery power by sending

irrelevant information.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

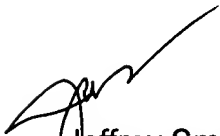Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Yogesh C. Garg
Primary Examiner

Conferees:

Jeffrey Smith
SPE AU3625

Matthew S. Gart
Primary Examiner AU 3625.